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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,737	08/27/2001	Cheng-Hao Chou	2760-15	5143
616	7590	08/24/2005	EXAMINER	
THE MAXHAM FIRM 750 "B" STREET, SUITE 3100 SAN DIEGO, CA 92101			VO, NGUYEN THANH	
			ART UNIT	PAPER NUMBER
			2685	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/940,737	CHOU, CHENG-HAO
	Examiner Nguyen T. Vo	Art Unit 2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 May 2005.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 33-50 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 33-50 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 27 August 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 46-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 46, the recitation "said communication device" at lines 3-4 lacks clear antecedent basis.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 33-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasnier (6,504,932, newly cited) in view of Japanese document 63-168755 (previously cited).

As to claim 33, Vasnier discloses a SIM card system having memory 23 (see figure 2) for storing digital data; a processor 21 coupled to the memory 23; a connector 211 for holding and connecting to a first SIM card (see column 3 lines 50-55); an input means 29 for inputting instructions to the processor (see column 5 lines 29-31); a power supply (inherently included in order to supply power to the components of the mobile

station); a display 28 for displaying the data (see column 5 lines 36-40). Vasnier fails to disclose that the SIM card system is a SIM card backup system, wherein the processor restores the data to a second SIM card according to the inputting instructions as claimed. Japanese document discloses memory card backup system (see the English translation). The backup system comprises a memory for reading, writing and storing results in access times (see the memory in the holder). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of the Japanese document to Vasnier, in order to obtain a reliable memory backup for the SIM card (as suggested by the Japanese document).

As to claims 34-35, 42-43, the combination of Vasnier and Japanese document does disclose a memory 23 (see Vasnier). The above combination, however, fails to disclose that the memory comprises a flash memory, or a EEPROM.

As to claims 36-37, 44-45, the combination of Vasnier and Japanese document does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a LED as claimed.

The examiner, however, takes Official Notice that a flash memory, EEPROM, LCD display and LED display are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claim 38, Vasnier discloses a keypad 29 (see figure 2).

As to claim 39, it is rejected for the same reasons as set forth in claim 33 above.

In addition, Vasnier does disclose a communication device with a communication module as claimed (see the cellular telephone in figure 2).

As to claims 40-41, Vasnier discloses the communication device is a mobile telephone (see column 1 lines 9-13; column 2 lines 45-51 and lines 61-64).

5. Claims 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vasnier (6,353,737, newly cited) in view of Japanese document 63-168755 (previously cited) and Erola (6,092,133, previously cited).

As to claim 46, first of all the rejection to claim 33 above over the combination of Vasnier and Japanese document is hereby incorporated. In addition, the above combination discloses using the SIM backup system in a mobile telephone instead of a PDA as claimed. Erola discloses SIM card can be used in a mobile telephone or a PDA (see column 11 lines 6-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the SIM card backup system in Erola, in order to obtain a multi-purpose mobile communication device (as suggested by Erola at column 11 lines 6-17).

As to claim 47, the combination of Vasnier and Japanese document and Erola does disclose a memory 23 (see Vasnier). The above combination, however, fails to disclose that the memory comprises a flash memory as claimed.

As to claims 48, 50, the combination of Vasnier and Japanese document and Erola does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a touch screen panel as claimed.

The examiner, however, takes Official Notice that a flash memory, LCD display and touch screen panel are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claim 49, Vasnier discloses a keypad 29 (see figure 2).

6. Claims 33-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarskog (WO 01/62029 A1, newly cited) in view of Vasnier (6,504,932, newly cited).

As to claim 33, Sarskog discloses a back up system (see figure 1) comprising a memory (see memory 5, 7); a processor; an input means; a power supply; a display (all inherently included in the computer 4, 6). Sarskog further discloses restoring the data to a second SIM card according to the inputting instruction as claimed (see page 1 line 31 to page 2 line 6; page 3 line 24 to page 4 line 4). Sarskog thus discloses all the claimed limitations except that the data transferred to and from the SIM cards via wireless medium, instead of via a connector for holding and connecting the SIM cards as claimed. Vasnier discloses a SIM card system having memory 23 (see figure 2) for storing digital data; a processor 21 coupled to the memory 23; a connector 211 for

holding and connecting to a first SIM card (see column 3 lines 50-55); an input means 29 for inputting instructions to the processor (see column 5 lines 29-31); a power supply (inherently included in order to supply power to the components of the mobile station); a display 28 for displaying the data (see column 5 lines 36-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Vasnier to Sarskog, so that data transferred from and to the SIM cards could be protected by encryption (as suggested by Vasnier).

As to claims 34-35, 42-43, the combination of Sarskog and Vasnier does disclose a memory 23 (see Vasnier). The above combination, however, fails to disclose that the memory comprises a flash memory, or a EEPROM.

As to claims 36-37, 44-45, the combination of Sarskog and Vasnier does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a LED as claimed.

The examiner, however, takes Official Notice that a flash memory, EEPROM, LCD display and LED display are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claim 38, Vasnier discloses a keypad 29 (see figure 2).

As to claim 39, it is rejected for the same reasons as set forth in claim 33 above.

In addition, Vasnier does disclose a communication device with a communication module as claimed (see the cellular telephone in figure 2).

As to claims 40-41, Vasnier discloses the communication device is a mobile telephone (see column 1 lines 9-13; column 2 lines 45-51 and lines 61-64).

7. Claims 46-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarskog (WO 01/62029 A1, newly cited) in view of Vasnier (6,353,737, newly cited) and Erola (6,092,133, previously cited).

As to claim 46, first of all the rejection to claim 33 above over the combination of Sarskog and Vasnier is hereby incorporated. In addition, the above combination discloses using the SIM backup system in a mobile telephone instead of a PDA as claimed. Erola discloses SIM card can be used in a mobile telephone or a PDA (see column 11 lines 6-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the SIM card backup system in Erola, in order to obtain a multi-purpose mobile communication device (as suggested by Erola at column 11 lines 6-17).

As to claim 47, the combination of Sarskog, Vasnier and Erola does disclose a memory 23 (see Vasnier). The above combination, however, fails to disclose that the memory comprises a flash memory as claimed.

As to claims 48, 50, the combination of Sarskog, Vasnier and Erola does disclose a display 28 (see Vasnier). The above combination, however, fails to disclose that the display comprises a LCD or a touch screen panel as claimed.

The examiner, however, takes Official Notice that a flash memory, LCD display and touch screen panel are known in the art, and such memories and displays can be used in the above combination without changing the scope and spirit of the invention of the combination. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the conventional memories and displays in the above combination, in order to reduce the system complexity because it employs already-existing memories and displays.

As to claim 49, Vasnier discloses a keypad 29 (see figure 2).

***Response to Arguments***

8. Applicant's arguments with respect to claims 33-50 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments with respect to Herzog are moot because Herzog is no longer relied in the rejection to the claims.

Regarding the Japanese document and Erola, applicant argues that the Japanese document and Erola fails to disclose any input means, any display, any processor as recited in the claim. It seems that applicant attacks references individually under a 35 USC 103 rejection. For a 103 rejection, applicant must consider the applied references as a whole. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986). In this case, the recited input means, display and processor are disclosed by Vasnier.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kim (US 2005/0096087 A1) and Del Tacca (EP 1 134 956 A1) disclose transferring data between two SIM cards.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T. Vo whose telephone number is (571) 272-7901. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (571)272-7899. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen Vo

Nguyen Vo  
8-20-2005

**NGUYEN T. VO**  
**PRIMARY EXAMINER**